

REMARKS

This amendment is in response to the Official Action mailed March 11, 2004. Claims 1-54 are pending in this application. Independent claims 1, 19 and 37 have been amended, and dependent claims 13, 31 and 49 have been canceled.

The Examiner rejected claims 1, 4-9, 12, 15-16, 19, 22-27, 30, 33, 34, 37, 40-45, 48, 51 and 52 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,788,064 ("Kori"). In addition, the Examiner rejected claims 2, 3, 20, 21, 38 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Kori in view of U.S. Patent No. 5,280,397 ("Rhodes"). The Examiner rejected claims 10, 11, 18, 28, 29, 36, 46, 47 and 54 under 35 U.S.C. § 103(a) as being unpatentable over Kori. In addition, the Examiner rejected claims 13, 31 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Kori in view of U.S. Patent No. 6,356,704 ("Callway"). As a final matter, the Examiner rejected claims 14, 17, 32, 35, 15 and 53 under 35 U.S.C. § 103(a) as being unpatentable over Kori in view of U.S. Patent No. 6,374,036 ("Ryan").

Kori discloses a first digital video tape recorder for reproducing from a magnetic tape a digital video signal having digital copy-prevention data, converting the digital video signal to a first analog signal, converting the copy-prevention data to a second analog signal, and mixing the first and second analog signals to provide an analog output signal. (See Kori, Fig. 6.) Kori further discloses a second digital video tape recorder for receiving the analog output signal, converting the first analog signal to digital form to provide the digital video signal, decoding the second analog signal to provide the copy-prevention data, and, if permitted by the copy-prevention data, recording the digital video signal on a magnetic tape. (*Id.*) If the copy-prevention data indicate that copying of the digital

video signal is prohibited, VBI decoder 51 provides a signal to gate 50 to prevent recording of the digital video signal. (See *Kori*, Fig. 8.)

Callway discloses a "method and apparatus for protecting access to audio and/or video data." (Abstract.) The data "is interpreted to determine whether an embedded data access parameter is active." (*Id.*) The data access parameter may comprise "copy restrictions, viewing restrictions, and/or use restrictions." (*Id.*) The data access parameter is provided to "a computer system such that unauthorized accessing, including unauthorized copying, of the video and/or audio data is prohibited." (*Id.*)

Applicants have amended independent claims 1, 19 and 37 to incorporate the subject matter of, respectively, dependent claims 13, 31 and 49. As amended, claim 1 now includes "notification means for notifying a user of said use limitation for said converted signal." Claims 19 and 37 include similar limitations. With respect to the embodiment of Fig. 1, the specification states:

The display information generation section 7 forms a display message for notifying that the control signal from the output condition determination section 44 indicates whether the video signal of the NTSC method from the signal conversion section 3 cannot be output or can be output, and supplies this message to the LCD 9 through the LCD driver 8. As a result, it is possible to quickly and accurately notify a user, in this embodiment, of whether or not the video signal of the NTSC method after signal conversion can be output to the LCD 9 As a result, when the signal after conversion is not output from the monitor receiver of this first embodiment, this is not misunderstood as a failure of the monitor receiver.

(Specification at 30-31.) Similar notification means are disclosed for the other embodiments disclosed in the specification.

With respect to canceled claims 13, 31 and 49, the Examiner contends, referring to *Callway* at Col. 2, lines 64-66, that this reference discloses notifying a user "with a visual indication of [the] use limitation for the converted signal." (Official Action at 9.) This contention is incorrect. The section of *Callway* to which the Examiner refers appears within the following paragraphs of this reference:

The video decoder 16 includes a graphics controller 20 and a video digitizer 22. The video digitizer 22 receives the video data 18 and converts it into a digital video stream; as a by-product of the analog to digital conversion, the embedded protection coding that resides in the synchronization portions (i.e., horizontal and vertical sync) of the video data is lost. The resulting digital video data 26 is provided to the memory 14 for storage therein. As stored, the digital video data 26 does not include the embedded protection coding, such that, without the present invention, the digital video data 26 could be readily copied as directed by the central processing unit 12.

The graphics controller 20, however, prevents the central processing unit 12 from directing any such authorized access to the digital data by providing it with an indication of protection 24. The graphics controller 20 generates the indication of protection 24 by monitoring the video data 18 for the embedded protection coding. When detected, the graphics controller 20 provides the indication of protection to the central processing unit which is programmed to respond accordingly. The indication may be an indication that some form of protection is available (Eg. that the video data is encoded with Macrovision) or the indication may clearly define the particular type of protection. For example, the protection may be limited viewing options, parental control, copying restrictions, use restrictions of particular data, where the copy restrictions may be a limited time of copying, such as copying still frames, no copying, copying with copyright notices, and/or reduced quality copying. The central processing unit 12, upon receipt of the particular level of protection, ensures that the computer system 10 would handle the video data as indicated by the level of protection.

(Callway at col. 2, line 49-col. 3, line 13; emphasis added.)

This discussion does not indicate that "indication of protection 24" is used by central processing unit 12, or any other element of Callway, to provide a visual indication, or any other form of indication, to a user that the video data stored in memory 14 cannot be used or copied.

The Examiner further contends that, "[a]s taught by Callway et al, a visual indication to a user that the signal is not being recorded because it is copy protected is a well-known, commercially available and widely used means and method of preventing user frustration from an unexplained anomaly in the operation of his equipment." (Official Action at 9.) As discussed above, however, Callway provides no such teaching. Also, as the Court of Appeals for the Federal Circuit explained in *In re Lee*, 61 U.S.P.Q.2d 1430, 1434-1435 (Fed. Cir. 2002), such reliance upon what the Examiner believes is well known is erroneous. The Court stated:

The "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation. This court explained in *Zurko*, 258 F.3d at 1385, 59 U.S.P.Q.2d at 1697, that "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

Applicants respectfully submit that the Examiner's reliance upon what he believes is well known is based upon impermissible, hindsight reconstruction of Applicants' invention.

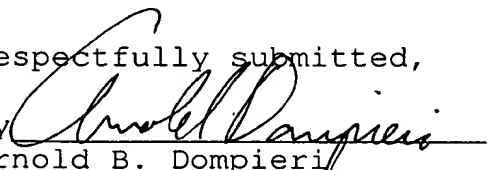
The other references cited by the Examiner do not overcome the deficiencies of *Kori* and *Callway*. *Rhodes* discloses a "television signal format converter . . . for converting without loss of picture information any high definition television format to or from a given recorder/player format." (Abstract.) *Ryan* discloses a method and apparatus for using a watermark in a video signal. Neither of these references addresses the problem of the present invention or provides a solution. The Examiner cited these references, moreover, only against Applicants' dependent claims (other than canceled claims 13, 31 and 49). Applicants' pending claims are patentable, therefore, over *Kori*, *Callway*, *Rhodes* and *Ryan*, whether considered individually or in combination.

In view of the foregoing, Applicants respectfully request the timely issuance of a Notice of Allowance in this application. If for any reason the Examiner does not believe that such action can be taken at this time, however, he is respectfully requested to telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections that he may have.

If there are any additional charges in connection with this amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: April 23, 2004

Respectfully submitted,

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